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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,859	05/11/2006	Jun Kitahara	09812.0129	3333
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
			EXAMINER VAUGHAN, MICHAEL R	
			ART UNIT 2131	PAPER NUMBER
			MAIL DATE 08/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/578,859

Applicant(s)

KITAHARA ET AL.

Examiner

MICHAEL R. VAUGHAN

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-8 is/are rejected.
7) ☒ Claim(s) 1, 2, 7 and 8 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 11 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 5/11/06
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

The instant application having Application No. 10/578,859 filed on 5/11/2006 is presented for examination by the examiner.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been received.

Claim Objections

Claims 1, 2, 7, and 8 are objected to because of the following informalities: each of these claims has the phrase "every contents" or "every the contents". This is mostly likely a mistranslation of the foreign patent and needs to be put into idiomatic English. Examiner advises Applicant to make any necessary changes to put the claims into better English form.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 7 is rejected under 35 U.S.C. 101 as directed to non-statutory subject matter. The claimed invention is nothing more than an abstract idea that is not a practical application producing a useful, concrete, and tangible result. A claimed series of steps or acts that do not result in a useful, concrete, and tangible result are not

statutory within the meaning of 35 U.S.C. 101. In this instance case, the claims recite, "processing". The notion of controlling an output is present, however, no useful, concrete, and tangible result is claimed. Absent such a result, the claims are not statutory.

Claim 8 is rejected under 35 U.S.C. 101 as directed to non-statutory subject matter of software, per se. The claim lacks the necessary physical articles or objects to constitute a machine or manufacture within the meaning of 35 U.S.C. 101. It is clearly not a series of steps or acts to be a process nor is it a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. It is at best, function descriptive material per se.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are non-statutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because

"[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). See MPEP 2106.01 [R-6].

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-8 are rejected under 35 U.S.C. 102(e) as being anticipated by USP 7,739,548 to Revital et al, hereinafter Revital.

As per claim 1, Revital teaches a license management method of performing management of license used in a contents distribution service in which contract of one channel is made so that plural contents distributed via the one channel are permitted to be utilized (col. 10, lines 5-7), the license management method comprising: offering, to an information processing apparatus [recipient module] which accepts an offer of contents, a first license [first layer] which prescribes utilization condition [access to protected content] of the entirety of plural contents distributed via the one channel (col. 5, lines 5-7 and col. 10, lines 10-15); and offering, to the information processing apparatus, along with contents, a second license [second layer] which prescribes, in a manner different from the first license,

utilization condition [assess to particular items or portions] every contents (col. 5, lines 9-10);

whereby in the case where the utilization condition prescribed by the first license and the utilization condition prescribed by the second license are both satisfied, the contents which have been offered along with the second license are permitted to be utilized at the information processing apparatus [properly decrypted] (col. 5, lines 35-37).

As per claims 2, 7, and 8 Revital teaches an information processing apparatus, method, and program adapted for processing contents provided by a contents distribution service in which contract of one channel is made so that plural contents distributed via the one channel are permitted to be utilized, the information processing apparatus comprising (col. 10, lines 5-7):

first acquisition means for acquiring a first license [first layer] which prescribes utilization condition [access to protected content] of the entirety of plural contents distributed via the one channel (col. 5, lines 5-7 and col. 10, lines 10-15);

second acquisition means for acquiring, along with contents, a second license [second layer] which is provided in a manner different from the first license and prescribes utilization condition [assess to particular items or portions] every contents; and

control means for controlling output of the contents which have been provided along with the second license in the case where the utilization condition prescribed by the first license and the utilization condition prescribed by the second license are both satisfied [properly decrypted] (col. 5, lines 35-37 and col. 16, lines 15-24).

As per claim 4, Revital teaches the control means decodes, by using first key information provided along with the first license [first layer], second key information provided in the state encrypted along with the second license [second layer] to decode encryption implemented to the contents by the second key information thus decoded (col. 5, lines 10-16).

As per claim 5, Revital teaches license management means for allowing any other information processing apparatus [plural recipient modules] to permit utilization of the contents which have been provided along with the second license within the scope where the utilization condition prescribed by the first license and the utilization condition prescribed by the second license are both satisfied (col. 5, lines 31-34).

As per claim 6, Revital teaches wherein in the case where plural contents [multiple portions or items of protected content] are distributed via the one channel successively in terms of time (col. 12, lines 11-13), the second acquisition means serves to acquire, during distribution of the first contents, the second license [second layer] which prescribes utilization condition [assess to particular items or portions] of second contents distributed subsequently to first contents, and the control means controls output of the second contents so that the second contents are outputted subsequently to the first contents in the case where the utilization condition prescribed by the first license and the utilization condition prescribed by the second license which prescribes the utilization condition of the second contents, which has been acquired by the second acquisition means, are both satisfied (col. 16, lines 15-24).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Revital.

As per claim 3, Revital teaches that during the manufacture of the recipient module an embedded key is stored in the hardware (col. 4, lines 38-42). Revital also teaches that any method of suitable encryption mechanism may be used for encrypting the various types of keys in his invention (col. 9, lines 52-53). Even though Revital does not explicitly call any of the secret keys, public-keys, it would be obvious to one of ordinary skill in the art that public key cryptography could easily be used in this case. The private stored key in the device would be the device's own unique private key. Then, any entity who wishes to create a session key (as taught by Revital) would simply encrypt the session key with the device's public key so only that specific device could decrypt the message and obtain the session key. Revital even teaches encrypting one key with another. This is a well established algorithm of key exchange. Anyone of ordinary skill in the art would readily use this algorithm. Therefore it would have obvious to one of ordinary skill in the art at the time of the invention to use the well known public key cryptography as a suitable encryption mechanism as Revital suggests.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP Application Publication 2003/0005135 teaches the use combining licenses for broadcasted media.

USP Application Publication 2003/00182579 teaches the idea of using multiple licenses to protect media.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. VAUGHAN whose telephone number is (571)270-7316. The examiner can normally be reached on Monday - Thursday, 7:30am - 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business

Art Unit: 2131

Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R. V./

Examiner, Art Unit 2131

/Ayaz R. Sheikh/

Supervisory Patent Examiner, Art Unit 2131